



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Before the Board of Patent Appeals and Interferences**

Applicant : Bryan Blair  
Serial No. : 09/738,023  
Filed : December 15, 2000  
For : METHOD AND SYSTEM FOR ISSUING INSURANCE  
UNDERWRITING INSTRUMENTS  
Examiner : Frenel, Vanel  
Art Unit : 3627

**APPEAL BRIEF**

May It Please The Honorable Board:

This is Appellants' Brief on Appeal from the final rejection of Claims 1, 3-6, 18 and 21, a Notice of Appeal having been filed on July 27, 2007. An amendment is filed contemporaneously. Accordingly, this Appeal Brief is timely filed and no fees are, therefore, believed to be due. Appellants waive an Oral Hearing for this appeal.

Please charge any additional fee or credit overpayment to the Deposit Account No. 50-3208. A single copy of the Brief has been enclosed.

**I. REAL PARTY IN INTEREST**

The real party in interest of Application Serial No. 09/738,023 is the assignee of record:

The Hartford Fire Insurance Company  
Hartford Plaza,  
Hartford, CT 06115

**II. RELATED APPEALS AND INTERFERENCES**

There are currently, and have been, no other related Appeals or Interferences regarding the subject application known to the undersigned attorney.

**III. STATUS OF THE CLAIMS**

Claims 1, 3-6, 18 and 21 are pending.

Claims 1, 3-6, 18 and 21 stand rejected.

The rejections of Claims 1, 3-6, 18 and 21 are appealed.

**IV. STATUS OF AMENDMENTS**

All prior amendments were entered. The claims included in the attached Claims Appendix reflect each of the prior amendments. A contemporaneously filed amendment amends Claim 21 to read consistent with amendments made in prior amendments and to remove an inadvertent typographical error in form of term "said."

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

This summary sets forth exemplary reference characters and pages and line numbers in the specification where an embodiment of each separately argued claim is illustrated or described. The identification of reference characters and pages and line numbers does not constitute a representation that any claim element is limited to the embodiment illustrated at the reference character or described in the referenced portion of the specification.

***Claim 1***

Independent Claim 1 is directed to a computer method for issuing at least one of a fidelity bond and a surety bond. *See, e.g., specification, pg. 1, ll. 12-15 ("The present invention relates to a method and system for completing insurance application forms, and more particularly to an automated system offering the capability to quote, issue and modify surety bonds and fidelity policies via a global telecommunications network such as the Internet"); see also, specification, pg. 7, ll. 5-6 ("Figure 21 illustrates a flowchart showing the steps utilized in underwriting a surety bond or fidelity policy according to an aspect of the present invention."); see also, Fig. 21, method 1000.*

The recited method of Claim 1 stores underwriting data so as to be accessible by at least one computer processor. *See, e.g., specification, pg. 23, ll. 16-18 ("system 10 retrieves 1070 from the database library 420 bond rates which have been established for appropriate geographic areas, e.g. each of the fifty states by zip code.").*

The recited method of Claim 1 stores data indicative of at least one of fidelity and surety bond customers so as to be accessible by said at least one computer processor. *See, e.g., specification, pg. 18, ll. 4-7 ("The policy database 420 manages particular business data for active and historic policies stored using the system 10 of the present invention. The policy database 420 services requests from other system components to retrieve and store information reliably."); see also, specification, pg. 23, ll. 5-13 ("Once an agent enters 1010 the system 10 using the user interface layer 100 for example, the system 10 inquires if a bond has previously been issued for a particular customer 1020. If yes, the database 420 can be searched 1025 for the basic information about that customer which can then be retrieved, thereby eliminating the need to repeatedly enter the customer information which also reduces the potential for error."); see also, Fig. 21.*

The recited method of Claim 1 includes inputting data indicative of at least one fidelity or surety bond to be issued and being associated with one of said bond customers. *See, e.g., specification, pg. 24, l. 20 – pg. 25, l. 3 (The agent then need only input the specific*

information regarding a contract for which the surety bond is to be a guarantee, or the business that is to be insured by a fidelity policy.”); see also, pg. 19, ll. 9-14 (“Referring now to Figure 3, if, for example, the user selects a surety bond, a second screen 510 such as is illustrated in Figure 3 is displayed which specifies types of surety bond that can be selected from a second general menu 511. Referring now also to Figures 4A and 4B, the system 10 preferably prompts the user to enter basic information regarding the client or policy holder requesting the bond.”); see also, specification, pg. 23, ll. 13-14 (“The agent then enters 1060 other basic information such as contract price and contract completion date if a surety bond is being quoted for example.”); see also, pg. 20, ll. 1-5 (“Since specific types of form require specific information to be entered, once a form is selected from the list 520, or otherwise identified, the system 10 prompts for any additional information necessary to complete the surety bond form as is illustrated by screens 530, 540, 550, 560 and 570 shown in Figures 6, 7, 8, 9 and 10.”); see also, Figs. 1, 3, 4A, 4B, 7 and 21.

The recited method of Claim 1 automatically calculates a premium for the at least one fidelity or surety bond to be issued based on the input data and the underwriting data in response to a request therefore. See, e.g., specification, pg. 21, ll. 7-10 (“Referring now to Fig. 20, the premium is then calculated based on the choices entered and the system 10 provides a pricing summary on a screen or display 710 that shows the premium for the fidelity policy, preferably by type of coverage.”); see also, specification, page 23, ll. 15-20 (“When this basic information such as the location of the contract or facility where the fidelity policy is to be issued is entered, the system 10 retrieves 1070 from the database library 420 bond rates which have been established for appropriate geographic areas, e.g. each of the fifty states by zip code. In the next step of the process, the premium is calculated 1050 for that policy, as well as the amount of commission to be paid to the agent 1120 using the ratings calculation engine 340.”); see also, specification, pg. 4, ll. 2-14 (“A method for issuing an insurance underwriting instrument ... including: ... automatically rendering the at least one form using the at least one rate, the data indicative of the customer, and data indicative of the insurance instrument.”); see also, Figs. 1, 20, 21.

The recited method of Claim 1 stores data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor. See, e.g., specification, pg. 17, ll. 17-18 (The forms library 410 preferably provides a repository for storing images of bond forms for the underwriter and other sureties.”); see also, Fig. 1.

The recited method of Claim 1, selects a sub-set of the data indicative of images of a plurality of pre-defined bond forms dependently upon the inputted data. See, e.g., specification, pg. 23, ll. 10-13 (“Once the customer information is recovered 1025 or otherwise entered 1030, the type of underwriting instrument and the necessary bond form is

*automatically selected 1040 based thereupon.”); see also, specification, pg. 19, ll. 15-17 (“Based upon the information entered, the system 10, provides a screen 515 as shown in Figure 5, which includes a list of bond forms 520 based on the type of surety bond entered previously.”); see also, Figs. 5, 15, 16 and 21.*

The recited method of Claim 1 automatically renders the at least one fidelity or surety bond to be issued using said data indicative of bond customers, said selected data indicative of images of a plurality of pre-defined forms, and calculated premium in response to a request therefore. *See, e.g., specification, pg. 17, l. 17 – pg. 18, l. 3 (“The forms library 410 preferably provides a repository for storing images of bond forms for the underwriter and other sureties. ... In addition to storing the actual bond form images, the library 410 also maintains information describing where on particular bond forms input fields are located. The forms rendering engine 330 in the business logic layer 300 uses this information to electronically fill out a bond form retrieved from library 410 with data provided by policy database 410.”); see also, pg. 20, ll. 1-5 (“Since specific types of form require specific information to be entered, once a form is selected from the list 520, or otherwise identified, the system 10 prompts for any additional information necessary to complete the surety bond form as is illustrated by screens 530, 540, 550, 560 and 570 shown in Figures 6, 7, 8, 9 and 10.”); see also, Figs. 1, 15 and 16.*

Finally, in the recited method of Claim 1, data indicative of said insurance underwriting instrument is automatically stored so as to be accessible to said at least one computer processor. *See, e.g., specification, pg. 18, ll. 4-7 (“The policy database 420 manages particular business data for active and historic policies stored using the system 10 of the present invention. The policy database 420 services requests from other system components to retrieve and store information reliably.”).*

### **Claim 18**

Claim 18 is directed to a data processing system for issuing a fidelity or surety bond. *See, e.g., specification, pg. 1, ll. 12-15 (“The present invention relates to a method and system for completing insurance application forms, and more particularly to an automated system offering the capability to quote, issue and modify surety bonds and fidelity policies via a global telecommunications network such as the Internet”); see also, Fig. 1.*

The system of Claim 18 includes at least one computer processor. *See, e.g., specification, pg. 14, ll. 16-19 (“The business logic layer 300 preferably includes transaction processor 310, form select server 320, forms rendering server 330, rating and premium calculation engine 340 and automatic renewal application 350.”); see also Fig. 1.*



The system of Claim 18 includes a first query-able plurality of memory locations storing data indicative of images of a plurality of forms, each of said forms being associated with a particular type of fidelity or surety bond. *See, e.g., specification, pg. 17, ll. 17-18 (The forms library 410 preferably provides a repository for storing images of bond forms for the underwriter and other sureties.)*; *see also, Fig. 1.*

The system of Claim 18 includes a second query-able plurality of memory locations storing data indicative of policies. *See, e.g., specification, pg. 18, ll. 4-7 ("The policy database 420 manages particular business data for active and historic policies stored using the system 10 of the present invention. The policy database 420 services requests from other system components to retrieve and store information reliably.")*.

The system of Claim 18 includes at least one user interface for inputting data indicative of an insurance client and data indicative of the fidelity or surety bond. *See, e.g., specification, pg. 23, ll. 5-13 (The agent then need only input the specific information regarding a contract for which the surety bond is to be a guarantee, or the business that is to be insured by a fidelity policy.)*; *see also, pg. 19, ll. 9-14 ("Referring now to Figure 3, if, for example, the user selects a surety bond, a second screen 510 such as is illustrated in Figure 3 is displayed which specifies types of surety bond that can be selected from a second general menu 511. Referring now also to Figures 4A and 4B, the system 10 preferably prompts the user to enter basic information regarding the client or policy holder requesting the bond.")*; *see also, specification, pg. 23, ll. 13-14 ("The agent then enters 1060 other basic information such as contract price and contract completion date if a surety bond is being quoted for example.")*; *see also, pg. 20, ll. 1-5 ("Since specific types of form require specific information to be entered, once a form is selected from the list 520, or otherwise identified, the system 10 prompts for any additional information necessary to complete the surety bond form as is illustrated by screens 530, 540, 550, 560 and 570 shown in Figures 6, 7, 8, 9 and 10.")*; *see also, Figs. 1, 3, 4A, 4B, 7 and 21.*

The system of Claim 18 includes at least one calculator application responsive to said user interface and automatically calculating a premium for the insurance underwriting instrument based on the input data using said at least one computer processor and data indicative of one of the fidelity or surety bond. *See, e.g., specification, pg. 16, ll. 8-11 ("The rating and premium calculation engine 340 executes logic and calculations required to rate policies and generate premiums. This component 340 implements business rules defined in suitable rating spreadsheets for example.")*.

Finally, the system of Claim 18 includes software for rendering selected ones of said plurality of forms using said data stored in said first and second pluralities of memory locations and calculated premium in response to a request from said user interface. *See, e.g.,*

*specification, pg. 15, l. 19 – pg. 16, l. 5 (“The forms rendering server 330 provides functions to automatically “fill out” a bond form identified from the bond library 410 by the server 320. The policy maintenance application 250 passes the bond form name and information to the forms rendering server 330, which in turn generates the information required to fill out the input fields on the retrieved bond form. When complete, the retrieved bond form and the data for the bond form are returned to the policy maintenance application 250, which sends this information to the user interface layer 100 so that the retrieved bond form including relevant data can be displayed or printed using a device 110.”*

### **Claim 21**

Claim 21 is directed to a computer method for issuing a fidelity or surety bond. *See, e.g., specification, pg. 1, ll. 12-15 (“The present invention relates to a method and system for completing insurance application forms, and more particularly to an automated system offering the capability to quote, issue and modify surety bonds and fidelity policies via a global telecommunications network such as the Internet.”); see also, Fig. 1.*

The method of Claim 21 includes identifying data stored in a plurality of memory locations and being indicative of a select one of a plurality of customers. *See, e.g., specification, pg. 23, ll. 5-13 (“Once an agent enters 1010 the system 10 using the user interface layer 100 for example, the system 10 inquires if a bond has previously been issued for a particular customer 1020. If yes, the database 420 can be searched 1025 for the basic information about that customer which can then be retrieved, thereby eliminating the need to repeatedly enter the customer information which also reduces the potential for error.”); see also, Fig. 21*

The method of Claim 21 includes receiving data indicative of a fidelity or surety bond to be associated with said select customer. *See e.g., specification, pg. 23, ll. 13-14 (“The agent then enters 1060 other basic information such as contract price and contract completion date if a surety bond is being quoted for example.”); see also, pg. 20, ll. 1-5 (“Since specific types of form require specific information to be entered, once a form is selected from the list 520, or otherwise identified, the system 10 prompts for any additional information necessary to complete the surety bond form as is illustrated by screens 530, 540, 550, 560 and 570 shown in Figures 6, 7, 8, 9 and 10.”); see also, Figs. 1, 3, 4A, 4B, 7 and 21.*

The method of Claim 21 includes automatically calculating at least one rate associated with said fidelity or surety bond to be associated with said select customer using said data indicative of said customer and data indicative of said fidelity or surety bond to be associated

with said select customer. *See e.g., specification, page 23, ll. 15-20 ("When this basic information such as the location of the contract or facility where the fidelity policy is to be issued is entered, the system 10 retrieves 1070 from the database library 420 bond rates which have been established for appropriate geographic areas, e.g. each of the fifty states by zip code. In the next step of the process, the premium is calculated 1050 for that policy, as well as the amount of commission to be paid to the agent 1120 using the ratings calculation engine 340."); see also, Figs. 1, 20, 21.*

The method of Claim 21 includes selecting at least one of a plurality of forms for said fidelity or surety bond using said data indicative of said fidelity or surety bond to be associated with said select customer. *See, e.g., specification, pg. 23, ll. 10-13 ("Once the customer information is recovered 1025 or otherwise entered 1030, the type of underwriting instrument and the necessary bond form is automatically selected 1040 based thereupon."); see also, specification, pg. 19, ll. 15-17 ("Based upon the information entered, the system 10, provides a screen 515 as shown in Figure 5, which includes a list of bond forms 520 based on the type of surety bond entered previously."); see also, Figs. 5, 15, 16 and 21.*

Finally, the method of Claim 21 includes automatically rendering said at least one form using said at least one rate, said data indicative of said customer, and data indicative of said fidelity or surety bond to be associated with said select customer. *See, e.g., specification, pg. 17, l. 17 – pg. 18, l. 3 ("The forms library 410 preferably provides a repository for storing images of bond forms for the underwriter and other sureties. ... In addition to storing the actual bond form images, the library 410 also maintains information describing where on particular bond forms input fields are located. The forms rendering engine 330 in the business logic layer 300 uses this information to electronically fill out a bond form retrieved from library 410 with data provided by policy database 410."); see also, pg. 20, ll. 1-5 ("Since specific types of form require specific information to be entered, once a form is selected from the list 520, or otherwise identified, the system 10 prompts for any additional information necessary to complete the surety bond form as is illustrated by screens 530, 540, 550, 560 and 570 shown in Figures 6, 7, 8, 9 and 10."); see also, Figs. 1, 15 and 16.*

In the method of Claim 21, the calculating and rendering are performed using at least one computing processor. *See, e.g., specification, pg. 14, ll. 5-7 ("The business logic layer 300 provides functions that require more intensive computer processing resources than application logic layer 200, and which may also require substantial scalability of the computing platform."); see also, specification, pg. 15, ll. 2-4 ("the transaction processor 310 does not directly perform business calculations or implement business rules, but rather routes those tasks to other components in the business logic layer 300 for more efficient processing."); see also, specification, pg. 16, ll. 8-11 ("The rating and premium calculation*

*engine 340 executes logic and calculations required to rate policies and generate premiums. This component 340 implements business rules defined in suitable rating spreadsheets for example.”); see also, specification, pg. 15, ll. 19-20 (“The forms rendering server 330 provides functionality to automatically “fill out” a bond form identified from the bond form library 410 by the server 320.”).*

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The Examiner has rejected Claims 1, 3-6, 18 and 21 as being unpatentable under 35 U.S.C. §103(a) over Luchs (United States Patent No. 4,831,526), in view of Bosco (United States Patent No. 5,191,522), further in view of Sforzo (United States Patent No. 7,194,435).

## **VII. ARGUMENT**

The recited methods of Claims 1, 3-6 and 21 and system of Claim 18 are patentable over Luchs in view of Bosco, and further in view of Sforzo, at least by virtue that: (1) a proper *prima facie* case of obviousness of any of the pending claims over the cited art has not been presented; and/or (2) a proper reason for modifying the primary reference Luchs is lacking; and/or (3) Luchs, Bosco and Sforzo fail, in any combination, to teach or suggest each of the recited limitations of any of the pending claims.

### **A. The Appealed Claims Are Directed To A Computer Method or System For Issuing A Fidelity Bond And/Or A Surety Bond.**

Underwriting insurance policies can be a complex and time consuming process. Many variables are considered in recognizing and qualifying risks associated with underwriting a particular insurance policy, such as the location of the insured party and the reason for that policy. In particular, with respect to fidelity policies and surety bonds, the location of the particular job to be insured as well as the total contract amount of the project are typically important factors in setting premium rates. Different localities, such as different states often have different premium rates. Also, different areas within a state can carry different levels of risks associated with construction projects, for example.

Because of the many types of businesses and contracts that fidelity policies and surety bonds can be used to provide against loss for, the myriad variety of different forms required for underwriting such policies and the types of information needed to complete these forms makes the underwriting process a time intensive and complex one.

The presently claimed invention seeks to address this problem via an automated system and methodology offering the capability to quote, issue and modify surety bonds and fidelity policies via a telecommunications network, such as the Internet.

### **B. Standard For Unpatentability Pursuant to 35 U.S.C. 103(a)**

35 U.S.C. §101 establishes that whoever invents or discovers any new and useful process or machine, or any new and useful improvement thereof, may obtain a patent therefor. *See, 35 U.S.C. §101*. Section 103 forbids issuance of a patent when the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. *See, KSR Int'l Co. V. Teleflex Inc.*, 127 S. Ct. 1727 (2007); *see also*, 35 U.S.C. §103(a).

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. *See, Id. citing Graham v. John Deere Co. of Kansas City*, 383 U. S. 1 (1966). Against this background the obviousness or non-obviousness of the subject matter is determined. *See, Id.*

The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-72 (Fed. Cir. 1984). To establish a *prima facie* case of obviousness under 35 U.S.C. 103(a), all of the recited claim limitations must be taught or suggested in the prior art. *See, M.P.E.P. 706.020; see also, M.P.E.P. 2143.03 citing In re Royka*, 490 F.2d 981(CCPA 1974) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.") and *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Further, a patent claim is not proved obvious merely by showing that each of its several elements was, independently, in the prior art. *See, KSR Int'l Co. V. Teleflex Inc.*, 127 S. Ct. 1727 *citing United States v. Adams*, 86 S. Ct. 708. Rather, an explicit analysis of as to whether there was an apparent reason to combine the known elements in the fashion claimed needs to be made. *See, KSR Int'l Co. V. Teleflex Inc.*, 127 S. Ct. 1727 *citing In re. Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.").

Further yet, each prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). A *prima facie* case of obviousness can be rebutted where the cited art teaches away from the claimed invention in any material respect. *See, In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001). A reference teaches away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the applicant. *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517.

Appellant may traverse the Examiner's *prima facie* determination as improperly made out. *In re Heldt*, 58 C.C.P.A. 701, 433 F.2d 808, 811, 167 USPQ 676, 678 (CCPA 1970).

**C. A *Prima Facie* Case Of Obviousness Is Lacking**

In the instant case, Appellant traverses the Examiner's *prima facie* determination of unpatentability as being improperly made out, as: (1) no reason for combining the selected elements of Luchs, Bosco and Sforzo to reach the claimed invention has been set forth; and/or (2) a proper reason for modifying the primary reference Luchs in the manner argued in the appealed rejections is lacking; and/or (3) no combination of Luchs, Bosco and Sforzo teach or suggest each of the recited limitations of any of the pending claims.

**1. The Office Action Fails To Provide Any Reason For Combining The Luchs And Bosco References.**

Each of the pending claims stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Luchs, Bosco and Sforzo. The Examiner can present a *prima facie* case of obviousness only by showing some reason to combine the cited references. *See, KSR Int'l Co. V. Teleflex Inc.*, 127 S. Ct. 1727 citing *United States v. Adams*, 86 S. Ct. 708.

The appealed rejections intermingle and refer to various portions of Luchs and Bosco as teaching different elements of the claimed invention. In particular, the appealed rejections begin by asserting that Luchs teaches certain elements of the claimed invention, and then inexplicably turn to Bosco as teaching other elements of the claimed invention. However, the appealed rejections do not provide any rationale as to how or why the cited teachings of Luchs and Bosco are being intermingled to reject the appealed claims. *See, e.g.*, 4/3/2007 Office action, par. 3(A) ("*As per claim 1, Luchs discloses storing underwriting data so as to be accessible by at least one computer processor (See Luchs, Col. 1, lines 63-68 to Col. 2, line 19; Col. 6, lines 13-68); wherein data indicative of said insurance underwriting instrument is automatically stored so as to be accessible to said one computer processor (See Luchs, Col. 1, lines 63-68 to Col. 2, line 19; Col. 6, lines 13-68); and calculated premium in response to a request therefore (See Bosco, Col.26, lines 63-68 to Col.27, line 52; see also pars. 3(F) (with regard to independent Claim 18) and 3(G) (with regard to independent Claim 21).*

It may be noted that while the appealed rejections assert a motivation for supposedly modifying the combined teachings of Luchs and Bosco with selected teachings of Sforzo, this does not remedy the wholesale failure of the appealed rejections to present any reason whatsoever for combining the cited teachings of Luchs and Bosco in the first place. Accordingly, a *prima facie* case of obviousness is clearly lacking as a matter of law.



Thus, Appellant requests reversal of the appealed rejections of Claims 1, 18 and 21, as no *prima facie* case of obviousness has been presented. Appellant also requests reversal of the rejections of Claims 3-6 as well, at least by virtue of these claims' ultimate dependency upon a patentably distinct base Claim 1.

**2. *A Proper Reason For Combining Luchs, Bosco and Sforzo To Reach The Presently Claimed Invention Is Necessarily Lacking.***

Notwithstanding that the above-discussed deficiency of the appealed rejections is sufficient to warrant reversal thereof, Appellant further submits a proper reason for combining the cited art to reach the presently claimed methods and system is lacking.

The recited method of Claim 1 stores data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor; selects a sub-set of the data indicative of images of a plurality of pre-defined bond forms dependently upon the inputted data; and automatically renders the at least one fidelity or surety bond to be issued using the selected data indicative of images of a plurality of pre-defined forms. A proper motivation for combining the teachings of Luchs, Bosco and Sforzo to include such a methodology is lacking.

As set forth above, each cited reference (including the primary reference Luchs) must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540. And, a *prima facie* case of obviousness can be rebutted where the cited art teaches away from the claimed invention in any material respect, *e.g.*, where upon reading the reference, one possessing an ordinary skill in the pertinent art would be led in a direction divergent from the path that was taken by the applicant. *In re Haruna*, 249 F.3d 1327.

In the present case, the primary reference Luchs teaches away from the recited invention of Claim 1. Luchs expressly teaches that when an insurance contract is to be issued, predetermined paragraphs are compiled and edited to create a custom tailored contract. *See, col. 3, l. 66 – col. 4, l. 11*. Luchs explains that the separate and complete paragraphs are then sequenced for printing in a desired order to yield an insurance contract. *See, col. 3, ll. 15-18*. Finally, Luchs explains that “[the approach of the Luchs’ system] is contrary to current practice wherein the client and the risk must be incorporated into existing contracts.” *See, col. 3, ll. 3-6*.

Accordingly, Luchs' teachings conflict and teach away from the presently recited invention of Claim 1, which calls for storing, selecting and using images of pre-defined bond forms -- at least by virtue that Luchs seeks to avoid the use of predefined bond forms altogether in favor of generating streamlined, custom tailored contracts one-by-one, client-by-client. Accordingly, a *prima facie* case of obviousness is lacking, as Luchs teaches away from the recited method of Claim 1 and a proper reason for modifying Luchs in a manner that contradicts its express teachings is lacking.

Further, the combined teachings of Luchs and Sforzo cannot properly discount Luchs' objective teaching to eliminate predefined forms to reach the method of Claim 1, which calls for storing, selecting and using images of pre-defined bond forms.

The appealed rejections argue "Sforzo suggests ... storing data indicative of a plurality of pre-defined bond forms so as to be accessible by said at least one processor (See Sforzo, Col.6, lines 34-55)". *April 3, 2007 Office action*, pg. 3, l. 20 – pg. 4, l. 9. However, a review of these cited passages reveals they are entirely silent with respect to bond forms at all, no less with respect to using pre-defined bond forms in a computerized method. Instead, the cited passages merely discuss the components of a computer system and the performance of a CPU. To be clear, the passages cited by the appealed rejections as allegedly teaching the use of "predefined bond forms" do not discuss bond forms at all.

Accordingly, Luchs expressly teaches away from the Claim 1 recited, "storing data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor", and the cited portions of Sforzo are entirely silent with respect thereto. Finally, Appellant notes Bosco is not relied upon in this regard by the appealed rejections.

For purposes of completeness, Claim 18 recites, *inter alia*, "memory locations storing data indicative of images of a plurality of forms." And, Claim 21 recites, *inter alia*, "selecting at least one of a plurality of forms for said insurance instrument."

Accordingly, Appellant requests reversal of the appealed rejections of Claims 1, 18 and 21, as a proper reason for combining the references as argued to reach the recited methods and system of the appealed claims is lacking, at least by virtue that the primary reference *Luchs* would lead one possessing an ordinary skill in the pertinent art in a direction divergent from the path that was taken (and is presently claimed) by the Applicant. Appellant also requests reversal of the rejections of Claims 3-6 as well, at least by virtue of these claims' ultimate dependency upon a patentably distinct base Claim 1.

**3. *The Cited Art Fails In Any Combination To Teach Or Suggest Each Of The Recited Limitations Of The Present Claims.***

Notwithstanding that the above-discussed deficiencies of the appealed rejections are sufficient to warrant reversal thereof, Appellant further submits the cited art fails, in any combination, to teach or suggest each of the limitations of any of the pending claims for at least the following reasons.

Appealed Claim 1 recites:

A computer method for issuing at least one of a fidelity bond and a surety bond comprising:

storing underwriting data so as to be accessible by at least one computer processor;

storing data indicative of at least one of fidelity and surety bond customers so as to be accessible by said at least one computer processor;

inputting data indicative of at least one fidelity or surety bond to be issued and being associated with one of said bond customers;

automatically calculating a premium for the at least one fidelity or surety bond to be issued based on the input data and the underwriting data in response to a request therefore;

storing data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor;

selecting a sub-set of the data indicative of images of a plurality of pre-defined bond forms dependently upon the inputted data; and

automatically rendering the at least one fidelity or surety bond to be issued using said data indicative of bond customers, said selected data indicative of images of a plurality of pre-defined forms, and calculated premium in response to a request therefore;

wherein data indicative of said insurance underwriting instrument is automatically stored so as to be accessible to said at least one computer processor.

The cited art fails to teach or suggest such a combination of features. Referring first to Claim 1, the appealed rejection thereof admits that Luchs and Bosco fail to teach or suggest the recited storing data indicative of images of a plurality of pre-defined bond forms. *See, April 3, 2007 Office action, pg. 3, ll. 6-19.* In an effort to remedy this admitted shortcoming of Luchs and Bosco, the appealed rejection of Claim 1 relies upon select

portions of Sforzo. However, a detailed reading of the Office action cited passages of Sforzo reveals Sforzo also fails to teach such a step.

The appealed rejections cite column 6, lines 34-55 of Sforzo to support the assertion that Sforzo teaches storing data indicative of images of a plurality of pre-defined bond forms. *April 3, 2007 Office action*, pg. 3, l. 20 – pg. 4, l. 9. Appellant traverses this assertion. These passages of Sforzo recite, in their entirety:

Referring now to FIG. 1B, a computer system in accordance with one embodiment of the present invention may include: one or more Central Processing Units (CPUs) 110; a terminal interface 150; an auxiliary storage interface 160; a workstation 170; a Direct Access Storage Device (DASD) 180; a floppy disk 190; a bus 140; and a memory 130 which includes multiple locations for containing various software programs. In this example, memory 130 includes a web browser 212 running in location 132, a web server application 222 running in location 134, an Internet/application gateway program 332 running in location 136, and a software application 342 running in location 138.

CPUs 110 perform computation and control functions of system 100. All CPUs associated with system 100 may each individually comprise a single integrated circuit, such as a microprocessor, or may comprise any suitable number of integrated circuit devices and/or circuit boards working in cooperation to accomplish the functions of a central processing unit. All CPUs are capable of suitably executing the programs contained within memory 130 and acting in response to those programs or other activities that may occur in system 100.

These cited passages of Sforzo simply do not teach or suggest “storing data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor”. Instead, these passages cited by the Examiner merely describe components of a computer system having a memory containing various software programs and the performance of a CPU. Clearly, the Examiner’s piecemeal rejection of the claimed invention is unsupported by the identified passages of the cited references, no less the cited references as a whole, law or fact.

Accordingly, the cited passages of Sforzo as articulated in the appealed rejections fail to remedy the recognized deficiencies of Luchs and Bosco (namely, at least “storing data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor”), such that a *prima facie* case of obviousness is lacking for at least this additional reason as well.

For purposes of completeness, Appellant again notes that Claim 18 recites, *inter alia*, “memory locations storing data indicative of images of a plurality of forms.” And, also again that Claim 21 recites, *inter alia*, “selecting at least one of a plurality of forms for said insurance instrument.”

Accordingly, Appellant requests reversal of the appealed rejections of Claims 1, 18 and 21, at least by reason that Luchs, Bosco and Sforzo fail, in any combination, to teach or suggest each of the limitations thereof as well. Appellant again also requests reversal of the rejections of Claims 3-6 as well, at least by virtue of these claims’ ultimate dependency upon a patentably distinct base Claim 1.

### VIII. CONCLUSION

Reversal of the 35 USC 103(a) rejections of Claims 1, 3-6, 18 and 21 as being unpatentable over Luchs (United States Patent No. 4,831,526), in view of Bosco (United States Patent No. 5,191,522), further in view of Sforzo (United States Patent No. 7,194,435), as asserted in the appealed rejections is requested, as: (1) no *prima facie* case of unpatentability has been presented; (2) the primary reference Luchs teaches away from the claimed invention such that a *prima facie* case of obviousness is lacking; and (3) Luchs, Bosco and Sforzo fail, in any combination, to teach or suggest each of the features recited by any of the appealed claims.

Respectfully submitted,

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**CLAIMS APPENDIX**

1. (Previously Presented) A computer method for issuing at least one of a fidelity bond and a surety bond comprising:

storing underwriting data so as to be accessible by at least one computer processor;  
storing data indicative of at least one of fidelity and surety bond customers so as to be accessible by said at least one computer processor;  
inputting data indicative of at least one fidelity or surety bond to be issued and being associated with one of said bond customers;  
automatically calculating a premium for the at least one fidelity or surety bond to be issued based on the input data and the underwriting data in response to a request therefore;  
storing data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor;  
selecting a sub-set of the data indicative of images of a plurality of pre-defined bond forms dependently upon the inputted data; and  
automatically rendering the at least one fidelity or surety bond to be issued using said data indicative of bond customers, said selected data indicative of images of a plurality of pre-defined forms, and calculated premium in response to a request therefore;  
wherein data indicative of said insurance underwriting instrument is automatically stored so as to be accessible to said at least one computer processor.

3. (Previously Presented) The method of Claim 1, wherein said inputting comprises presenting at least one electronic document to a user via a browser functionality of software running on a microprocessor based device, and communicating data input to said software by said user to said at least one computer processor.

4. (Original) The method of Claim 1, further comprising automatically calculating a premium for at least one alternative insurance underwriting instrument having at least one characteristic differing from said insurance underwriting instrument.

5. (Original) The method of Claim 1, further comprising automatically storing said input data.

6. (Original) The method of Claim 1, further comprising:  
providing data indicative of images of a plurality of insurance underwriting instruments;  
wherein said rendering comprises selecting one of said instruments dependently upon said input data; and  
uses at least a portion of said data indicative of images of said plurality of underwriting instruments being associated with said selected one of said instruments.
18. (Previously Presented) A data processing system for issuing a fidelity or surety bond, the system comprising:  
at least one computer processor;  
a first query-able plurality of memory locations storing data indicative of images of a plurality of forms, each of said forms being associated with a particular type of fidelity or surety bond;  
a second query-able plurality of memory locations storing data indicative of policies;  
at least one user interface for inputting data indicative of an insurance client and data indicative of the fidelity or surety bond;  
at least one calculator application responsive to said user interface and automatically calculating a premium for the insurance underwriting instrument based on the input data using said at least one computer processor and data indicative of one of the fidelity or surety bond; and  
software for rendering selected ones of said plurality of forms using said data stored in said first and second pluralities of memory locations and calculated premium in response to a request from said user interface.
21. (Currently amended) A computer method for issuing a fidelity or surety bond comprising:  
identifying data stored in a plurality of memory locations and being indicative of a select one of a plurality of customers;  
receiving data indicative of a fidelity or surety bond to be associated with said select customer;  
automatically calculating at least one rate associated with said fidelity or surety bond to be associated with said select customer using said data indicative of said customer and data indicative of said fidelity or surety bond to be associated with said select customer;



selecting at least one of a plurality of forms for said ~~insurance instrument~~ fidelity or surety bond using said data indicative of said fidelity or surety bond to be associated with said select customer; and

automatically rendering said at least one form using said at least one rate, said data indicative of said customer, and data indicative of said fidelity or surety bond to be associated with said select customer;

wherein, said calculating and rendering are performed using [[said]] at least one computing processor.

**EVIDENCE APPENDIX**

None

**RELATED PROCEEDINGS APPENDIX**

None.

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**LIST OF REFERENCES APPENDIX****PATENTS**

<b><u>U.S. Pat. No.</u></b>	<b><u>Issued Date</u></b>	<b><u>Inventors</u></b>
4,831,526	<u>05/16/1989</u>	Luchs, et al.
5,191,522	<u>03/02/1993</u>	Bosco, et al.
7,194,435	<u>03/20/2007</u>	Sforzo

**NON- PATENT REFERENCES**

None

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